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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,234	03/12/2004	Sze-Moey Voon	200314061-1	8846

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EXAMINER

HARRIS, ANTON B

ART UNIT	PAPER NUMBER
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2831

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/800,234	VOON ET AL.	
	Examiner	Art Unit	
	Anton B. Harris	2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1--20 is/are pending in the application.
- 4a) Of the above claim(s) 12-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-11 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lajara et al. (6,373,697) in view of Tung-Chieh et al. (Pub. No. US 2003/00164487).

Regarding claim 1, Lajara et al. (abstract) discloses a housing comprising an inside (figure 12A), a storage compartment (figure 12A) including a body 12 having an interior (figure 12A), a bottom (figure 12A) and a sidewall 14A, 14B that define the interior, and a passage (figure 12A) connecting an item disposed within the interior (figure 12A) and communicatively coupled to another item outside the interior (figure 12A), and a lid 16, but lacks a storage compartment external to the inside of the housing.

Tung-Chieh et al. (page 2 paragraph 0022) teaches a storage compartment 202 external to the inside of the housing 200.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Lajara et al. by providing a storage compartment external to the inside of the housing in order to transfer data with the expansion card in view of the teachings of Tung-Chieh et al.

Furthermore, the limitation of “operable to contain processing circuitry” and “to allow an item disposed within the interior to be communicatively coupled to another item outside the interior” in claim 1 have been considered, but do not result in a structural difference. It has been held that a recitation that an element is “operable to” or “allowed to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Regarding claim 2, the teachings of Tung-Chieh et al. further include that the interior 200 is sized to retain a PDA.

Regarding claim 3, the teachings of Tung-Chieh et al. further include that the interior 200 is sized to hold storage media 300.

Regarding claim 4, Lajara et al. (abstract) discloses that the sidewall 14A, 14B includes the passage.

Regarding claim 5, Lajara et al. (abstract) discloses that the storage compartment (figure 12A) includes a coupling element (figure 12A) operable to couple the lid 16 to the sidewall 14A, 14B.

Regarding claim 6, Lajara et al. (abstract) discloses that the storage compartment (figure 12A) includes a locking element (col. 6, lines 59-63) operable to retain the lid 16 in a closed position.

Regarding claim 7, Lajara et al. (abstract) discloses that: the housing 10 further comprises a conduit (figure 12A) having an opening (figure 12A); and the passage (figure 12A) opens to the conduit's opening (figure 12A).

Regarding claim 8, Lajara et al. (abstract) discloses a housing 10 comprising an inside (figure 12A), a storage compartment (figure 12A) including a body 12 having an interior (figure 12A), a bottom (figure 12A) and a sidewall 14A, 14B that define the interior (figure 12A), and a lid 16 having an opening (figure 12A), but lacks a storage compartment external to the inside of the housing.

Tung-Chieh et al. (page 2 paragraph 0022) teaches a storage compartment 202 external to the inside of the housing 200.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Lajara et al. by providing a storage compartment external to the inside of the housing in order to transfer data with the expansion card in view of the teachings of Tung-Chieh et al.

Furthermore, the limitation of “operable to contain processing circuitry” and “operable to allow access to an item disposed within the interior” in claim 8 have been considered, but do not result in a structural difference. It has been held that a recitation that an element is “operable to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Regarding claim 9, Lajara et al. (abstract) discloses that the interior (figure 12A) is sized to retain a camera docking station (figure 12A), and when a camera (figure 12A) is coupled to

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the docking station (figure 12A), the camera (figure 12A) protrudes through the opening (figure 12A).

Regarding claim 10, Lajara et al. (abstract) discloses a computer system comprising processing circuitry, a housing 10 having an inside containing the processing circuitry (figure 12A) and a storage compartment (figure 12A) to retain an item and including a body 12 having an interior (figure 12A), a bottom (figure 12A) and a sidewall 14A, 14B that define the interior, and a passage (figure 12A), and a lid 16, but lacks a storage compartment external to the inside of the housing.

Tung-Chieh et al. (page 2 paragraph 0022) teaches a storage compartment 202 external to the inside of the housing 200.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Lajara et al. by providing a storage compartment external to the inside of the housing in order to transfer data with the expansion card in view of the teachings of Tung-Chieh et al.

Furthermore, the limitation of “operable to allow an item disposed within the interior to be communicatively coupled to another item outside the interior” in claim 10 has been considered, but does not result in a structural difference. It has been held that a recitation that an element is “operable to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Regarding claim 11, Lajara et al. (abstract) discloses a computer system comprising processing circuitry (figure 12A), a housing 10 having an inside containing the processing

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circuitry and a storage compartment (figure 12A) to retain an item and including a body 12 having an interior (figure 12A), a bottom (figure 12A) and a sidewall 14A, 14B that define the interior (figure 12A), and a lid 16 having an opening (figure 12A), but lacks a storage compartment external to the inside of the housing.

Tung-Chieh et al. (page 2 paragraph 0022) teaches a storage compartment 202 external to the inside of the housing 200.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Lajara et al. by providing a storage compartment external to the inside of the housing in order to transfer data with the expansion card in view of the teachings of Tung-Chieh et al.

Furthermore, the limitation of “operable to allow an item disposed within the interior to be communicatively coupled to another item outside the interior” in claim 10 has been considered, but does not result in a structural difference. It has been held that a recitation that an element is “operable to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Regarding claims 17-20, the teachings of Tung-Chieh et al. further include that the storage compartment 202 is located above the housing's 200 inside.

Response to Arguments

3. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anton B Harris whose telephone number is (571) 272-1976. The examiner can normally be reached on weekdays from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Dean Reichard, can be reached on (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

ABH
7/26/06


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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800
8/7/06
DR